

18M1/0807

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EXAMINER

UNGAR.S

ART UNIT

1806

PAPER NUMBER

DATE MAILED: 08/07/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

this is a  
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48



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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08/14/97

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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1581/1506

EXAMINER
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ART UNIT	PAPER NUMBER
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1506

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DATE MAILED: 08/19/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on Election filed 7/14/97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s) of thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11-15 + 37 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claim(s) 11-15 + 37 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

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1. The Response to the Restriction Requirement filed July 18, 1997 (Paper No. 7) in response to the Office Action of June 10, 1997 (Paper No. 6) is acknowledged and has been entered.
  2. Applicant's election with traverse of Group I, claims 11-15 in Paper No 7 is acknowledged. The traversal is on the ground(s) that the instant divisional application corresponds to Group IV of the four-way Restriction Requirement issued in the parent application and that the instant application claims the benefit under 35 USC 120 of prior applications dating to 31 July 1989 and that the Office is prohibited pursuant to 37 1.129(b)(1) from maintaining the requirement for restriction of the instant application. The argument has been noted but has not been found persuasive because the restriction requirement of the instant application is not identical to that of the parent application, therefore, this application is subject to the transitional restriction provisions of Public Law 103-465 as follows:
    3. This application is subject to the transitional restriction provisions of Public La 103-465, which became effective on June 8, 1995, because:
      1. the application was filed on or before June 8, 1995, and has an effective U.S. filing date of June 8, 1992, or earlier;
      2. a requirement for restriction was not made in the present or a parent application prior to April 8, 1995; and
      3. the examiner was not prevented from making a requirement for restriction in the present or a parent application prior to April 8, 1995, due to actions by the applicant.
- The transitional restriction provisions permit applicant to have more than one independent and distinct invention examined in the same application by

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paying a fee for each invention in excess of one by paying a fee for each invention in excess of one.

Final rules concerning the transition restriction provisions were published in the Federal Register at 60 FR 20195 (April 25, 1995) and in the Official Gazette at 1174 O.G. 15 (May 2, 1995). The final rules at 37 CFR 1.17(s) include the fee amount required to be paid for each additional invention as set forth in the following requirement for restriction. See the current fee schedule for the proper amount of the fee.

Applicant must either: (1) elect the invention or inventions to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention in excess of which applicant elects; or (2) file a petition under 37 CFR 1.129(b) traversing the requirement.

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

**Group I.** Claims 11-15 are drawn to a recombinant DNA sequence encoding human thyroid peroxidase which is secreted from a cell and a vector comprising the DNA sequence classified in Class 536, subclass 23.1 and Class 435 subclass 320.1.

**Group II.** Claim 37 is drawn to a DNA sequence encoding a peptide which binds to the B-cell epitope of thyroid peroxidase, classified in Class 536, subclass 23.1.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II as disclosed are chemically distinct, unrelated in structure and function, used in different methods and are therefore distinct

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inventions.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Upon review of the application, the Notice to Comply with the Sequence Rules is withdrawn.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 308-305-2181.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached at (703) 308-2731. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Susan Ungar

August 6, 1997



Handwritten signature of Philip Gambel, dated 8/6/97.

PHILLIP GAMBEL  
PATENT EXAMINER  
GROUP 1800